

Remarks

Amendments to the Claims

The amendments to the claims to not add new matter. Claim 2 is amended to recite a step of “contacting a PRSC1 polypeptide with a test compound,” which the specification supports on pages 30-38. Renumbered steps (ii) and (iii) are rephrased for clarity. The specification supports new step (iv), *e.g.*, on page 31, lines 11-16. New claim 27 is supported on page 31, lines 11-16 and 27-29.

Objection to Claim 4

Claim 4 is amended as suggested on page 2 of the Office Action.

Rejections Under 35 U.S.C. § 112 ¶ 2

Claims 2 and 4-11 are rejected under 35 U.S.C. § 112 ¶ 2 as being incomplete (Office Action at page 2) and indefinite (Office Action at page 3).

Claim 2 is amended to recite steps that the Office Action identifies as missing. This amendment also addresses the alleged indefiniteness of claim 2 discussed on page 3 of the Office Action and provides antecedent basis for the recitations in claims 4 and 6 of “the step of contacting.”

The Office Action states that there is no antecedent basis for the recitation “the cells” in claim 5. Claim 5 does not recite “the cells”; it recites “the cell,” which has antecedent basis in claim 4.

Please withdraw the rejections.

Rejection Under 35 U.S.C. § 103(a)

Claims 2 and 4-10 are rejected as obvious over Balasubramanian¹ in view of Parce.² Claim 11 is rejected as obvious over Balasubramanian, Parce, and Fodor.³ Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, an examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Independent claim 2 is directed to a screening method to identify agents which may be useful in the treatment of a particular group of recited diseases. The Office Action cites Balasubramanian as teaching “a method of screening useful therapeutics in treating immunological diseases” and cites col. 28, lines 5-9 and col. 41, lines 35-37 of Balasubramanian. The Office Action then bases the obviousness rejection on the assertion that “[i]t is considered that some of the diseases in the recited method, such as cancer, inflammation, or endocrinological diseases, are associated with immunological dysfunction.” Office Action at page 4, item 6.

There is no legal or scientific justification for making this leap. The cited portions of Balasubramanian relate to diagnosis of “immune-compromised conditions” or an “immune problem.” At column 28, lines 5-9, Balasubramanian merely teaches that “[b]y assaying the expression products of cells expressing APG04, FDH02, or D1B2 proteins it is possible to diagnose disease, e.g., immune-compromised conditions.” Similarly, at column 41, lines 34-37, Balasubramanian teaches that “[t]hese sequences can be used as probes for detecting levels of the

¹ Balasubramanian *et al.*, U.S. Patent 6,140,098.

² Parce *et al.*, *Science* 246, 243-47, 1989.

³ Fodor *et al.*, *Science* 251, 767-73, 1991.

APG04, FDH02, or D1B2 protein message in samples from natural sources, or patients suspected of having an abnormal condition, e.g., immune problem.” There is no suggestion in either of the cited portions of Balasubramanian – or in any other portion of that reference – to use any of the disclosed proteins to screen for therapeutics for treating any of the particular conditions recited in claim 2. None of the cited secondary references remedies this defect. It is black letter law that obviousness requires at least a suggestion of all of the features in a claim. See *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974).

The Office Action has not made a *prima facie* case that any of claims 2 and 4-11 is obvious. Please withdraw the rejection.

Respectfully submitted,

BANNER & WITCOFF, LTD.

/Lisa M. Hemmendinger/

By: _____
Lisa M. Hemmendinger
Registration No. 42,653

Date: November 18, 2008

Customer No. 22907
202-824-3000